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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,146	03/16/2004	Tomoe Kitani	KON-1861	3266
20311	7590	06/06/2005	EXAMINER	
MUSERLIAN, LUCAS AND MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016			GUADALUPE, YARITZA	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

EX

Office Action Summary	Application No. 10/802,146	Applicant(s) KITANI ET AL.	
	Examiner Yaritza Guadalupe McCall	Art Unit 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-8 and 10 is/are rejected.
- 7) ☒ Claim(s) 4, 5 and 9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1 – 3, 6 – 8 and 10 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 - 3, 5, 7, 9 – 10 and 13 - 16 of copending Application No. 10/798,027 [Hereinafter '027]. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

With respect to claim 1, copending application '027 claims (see claims 1, 5 and 10) a plurality of image forming units each having at least an electrophotographic photoreceptor, a latent image forming device to form an electrostatic latent image on electrophotographic photoreceptor, developing device to develop the electrostatic latent image with toner form visible toner image on the electrophotographic photoreceptor, transferring device to transfer the visible toner image onto a toner image receiving member and a cleaning device to remove the toner remaining on the electrophotographic photoreceptor after transferring the visible toner image by the transferring device, wherein the plurality of image forming units are arranged so as to transfer and pile up the visible toner images successively onto the toner image receiving member to form a toner image, and wherein the toners used in each of the image forming units have different colors and the turbidity of less than 60; and the difference of the turbidity the toner having the highest turbidity and that of the toner having the lowest turbidity among the toners is 5 to 45.

In regards to claim 2, copending application '027 also claims (see claims 2 and 7) an image forming apparatus wherein said toner image receiving member is an intermediate transferring device which retransfers said toner image transferred and piled up by the image forming units onto a recording material.

Regarding claim 3, copending application '027 claims an image forming apparatus wherein a surface layer of the electrophotographic photoreceptor of at least one the plural image forming units contains fluoro-resin particle (see claim 13).

With regards to claim 6, copending application '027 further claims an image forming apparatus wherein the difference of the turbidity of the toner having the highest turbidity and that of the toner having the lowest turbidity among the toners is 10 to 35 (see claims 3 and 14).

Regarding claim 7, copending application '027 claims an image forming apparatus wherein the image forming units are four image forming units composed of an image forming unit having a black toner, an image forming unit having a yellow toner, an image forming unit having a magenta toner and an image forming unit having a cyan toner (see claims 1, 5 and 10).

In regards to claim 8, copending application '027 claims (see claims 9 and 15) an image forming apparatus wherein the turbidity the black toner less than 20.

With respect to claim 10, copending application '027 also claims (see claim 16) an image forming method, comprising the steps of forming respective color latent images of yellow, magenta, cyan and black, on a plurality of electrophotographic photoreceptor; developing the respective color latent images with corresponding color toners to form respective color visible toner images; and transferring the respective color toner images successively to be piled up on a toner image receiving member, wherein the toner has the turbidity of less than 60, and the difference of the turbidity of the toner having the highest turbidity and that of the toner having the lowest turbidity among the toners is 5 to 45.

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3. Claim 10 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application No. 10/802,470. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

With respect to claim 10, copending application '470 also claims (see claim 1) an image forming method, comprising the steps of forming respective color latent images of yellow, magenta, cyan and black, on a plurality of electrophotographic photoreceptor; developing the respective color latent images with corresponding color toners to form respective color visible toner images; and transferring the respective color toner images successively to be piled up on a toner image receiving member, wherein the toner has the turbidity of less than 60, and the difference of the turbidity of the toner having the highest turbidity and that of the toner having the lowest turbidity among the toners is 5 to 45.

Allowable Subject Matter

4. Claims 4, 5 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following reference are considered of relevance to the present application :

- a. Nakamura et al. (US 6,641,965)
- b. Shoji et al. (US 4,839,692)
- c. Itakura et al. (US Pub. No. 2005/0014079)
- d. Tomita et al. (US 5,164,774)
- e. Ito et al. (US Pub. No. 2005/0018218)
- f. Matsumoto et al. (US Pub. No. 2005/0089779)
- g. Ayaki et al. (US Pub. No. 2005/0106481)

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaritza Guadalupe McCall whose telephone number is (571)272-2244. The examiner can normally be reached on 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



YGM
June 2, 2005

Yaritza Guadalupe-McCall
Patent Examiner
Art Unit 2859